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CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			FISCHER, ANDREW J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/973,303

Applicant(s)

OGASAWARA, NOBUO

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 34-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Acknowledgments*

1. The amendment (Amendment 'E') filed September 22, 2003 (Paper No. 15) is acknowledged. Accordingly, claims 1, 3-9, and 34-40 remain pending.

### *Specification*

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and §2181. Correction of the following is required:

- a. The “means for determining shelf-life limitation information” as recited in claim 1.
- b. The “means for recording said shelf-life limitation information” as recited in claim 1.
- c. The “means for electronically recording said shelf-life limitation information” as recited in claim 1.
- d. The “means for retrieving the shelf-life limitation information” as recited in claims 1 and 35.

The claims are replete with the above errors. The Examiner *highly* recommends Applicant review *all* pending claims to ensure that all “means for” phrases have proper antecedent basis in the specification.

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*Drawings*

3. The drawings are objected to as failing to comply with 37 C.F.R. §1.84(p)(4) because reference character “20” has been used to designate both “a web server 20 (page 7, line 23) and “the customer’s Internet connection 20.” (Page 7, line 30). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are also objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following are merely examples of what must be shown or the features canceled from the claim(s):

- a. The “means for determining shelf-life limitation information” as recited in claim 1.
- b. The “means for formatting” as recited in claim 4.
- c. The “means for converting” as recited in claim 9.

5. The Examiner notes the claims are replete with the above drawing errors. All structural elements recited in claims 1, 3-9, 34-40 are clearly not shown in the drawings. The Examiner *highly* recommends Applicant review *all* pending claims to ensure that *every* structural element claimed is shown in the drawings. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 3-9, 34-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claim 1, it is unclear what is the corresponding structure of the “means for determining shelf-life limitation information.”

b. In claim 1, it is unclear what is the corresponding structure of the “means for recording said shelf-life limitation information.”

c. In claim 1, it is unclear what is the corresponding structure of the “means for electronically recording said shelf-life limitation information.”

d. In claim 3, it is unclear what is the corresponding structure of the “means for storing said communicated electronic shelf-life information.”

e. In claim 4, it is unclear what is the corresponding structure of the “means for formatting.”

f. In claim 5, it is unclear what is the corresponding structure of the “means for displaying.”

g. In claim 6, it is unclear what is the corresponding structure of the “means for the purchaser to interact with said onscreen display.”

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h. In claim 9, it is unclear what is the corresponding structure of the “means for converting.”

i. Claim 37 recites the limitation “the second processor” in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim.

8. Regarding all the “means for” phrases, the Examiner notes that the claims are replete with these errors. Applicant is also reminded, “For claim clauses containing functional limitations in ‘means for’ terms pursuant to §112 ¶ 6, the claimed function and its supporting structure in the specification must be presented with sufficient particularity to satisfy the requirements of §112 ¶ 2.” *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001) (citations omitted). In other words, “[f]ailure to describe adequately the necessary structure, material, or acts corresponding to a means-plus-function limitation in the written description means that the drafter has failed to comply with Section 112, Para. 2.” *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1380 53 USPQ2d 1225, 1229 (Fed. Cir. 1999) citing *In re Dossel*, 115 F.3d 942, 945, 42 USPQ2d 1881, 1884 (Fed. Cir. 1997)). And as the Federal Circuit noted in *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 68 USPQ2d 1263 (Fed. Cir. 2003):

The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express the claim in terms of function under section 112, paragraph 6. Section 112, paragraph 6 was intended to allow the use of means expressions in patent claims without requiring the patentee to recite in the claims all possible structures that could be used as means in the claimed apparatus. However, the price that must be paid for use of that convenience is limitation of the claim to the means specified in the written

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description and equivalents thereof. If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid that price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification. Such is impermissible under the statute.” *Medical Instrumentation*, 68 USPQ2d at 1268 (citations and quotations omitted).

In this case, because of the numerous 35 USC §112 2<sup>nd</sup> paragraph rejections regarding corresponding structure and the claim objections noted above, Applicant has clearly not “paid that price.” That is Applicant is attempting to claim functional terms unbounded by any reference to structure in the specification.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-9, 34-38, and 40, as understood by the Examiner rejected under 35 U.S.C. 102(b) as being Colella et. al. (U.S. 6,003,006)(“Colella”). Colella discloses a means for determining shelf-life information for items (displaying it on a computer monitor); means for recording shelf-life information and a data store (an ordinary computer hard drive or barcode); mean accessible to a POS terminal for reading recorded information and a scanner (a first barcode scanner at the hospital pharmacy) attached to a first terminal; means for electronically recording

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the shelf-life information (a barcode); means for storing electronic shelf-life information (a computer keyboard); means for formatting (the video driver in the computer); means for displaying as an on-screen display (a computer monitor); shelf-life limitation information includes a period for which the product remains viable (inherent in all shelf-lives); and an electronic receipt (electronic acknowledgment of drugs transferred).

11. Claims 1, 3-9, and 34-40, as understood by the Examiner, are also rejected under 35 U.S.C. 102(b) as being Swartz et. al. (U.S. 5,923,735) ("Swartz"). Swartz discloses a means for determining shelf-life information for items (displaying it on a computer monitor); means for recording shelf-life information and a data store (an ordinary computer hard drive or barcode); mean accessible to a POS terminal (74) for reading recorded information and a scanner (a first barcode scanner at the hospital pharmacy) attached to a first terminal; means for electronically recording the shelf-life information (a barcode) and an IC card (customer card); a touchscreen unit; means for storing electronic shelf-life information (a computer keyboard); means for formatting (the video driver in the computer); means for displaying as an on-screen display (a computer monitor); shelf-life limitation information includes a period for which the product remains viable (inherent in all shelf-lives); and an electronic receipt (the record of customer purchases downloaded from the store sever).



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*Claim Rejections - 35 USC § 103*

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 3-9, and 34-40, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz in view of Tognazzini (U.S. 5,739,512).<sup>1</sup> It is the Examiner principle position that claims 1, 3-9, and 34-40 are anticipated because of the electronic receipt is inherent in the customer's downloading of their purchase records and historical shopping profile which may be used to create a future shopping list.

However if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Swartz as taught by Tognazzini and include Tognazzini's electronic receipt. Such a modification would have allowed the customer to send their electronic receipts via email so that a third party (e.g. employer or the government) could ultimately pay for the transaction(s).

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<sup>1</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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14. With respect to the pending claims, the Examiner notes the following: "A system is an apparatus." *Ex parte Fressola*, 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant's system claims are "product," "apparatus," or more specifically, "machine" claims.<sup>2</sup>

15. In light of the above fact that Applicant has chosen product claims, functional recitations using "configured to," "for," or "to" (e.g. "for a product" as recited in claim 35, lines 3 and 4; and "to identify deleted items" as recited in claim 7) in the claims have been considered but are given less patentable weight<sup>3</sup> because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459

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<sup>2</sup> Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

<sup>3</sup> See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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(CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

If Applicant desires to give the phrase greater patentable weight, the Examiner respectfully recommends Applicant remove “configured to” and “for”-only phrases from the claims where intended use is not desired (*e.g.* “the first terminal *receiving* the scanned product indica”). Like always, such amendments must not constitute new matter and must be supported in Applicant’s specification.

16. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant to be his own lexicographer and to define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the “heavy presumption” that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and

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customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).<sup>4</sup>

In accordance with the ordinary and accustom meaning presumption and except as interpreted as under 35 U.S.C. 112 6<sup>th</sup> paragraph *infra*, during examination the claims are interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>5</sup>

However, if Applicant disagrees with the Examiner and has either (a) already used lexicography or (b) wishes to use lexicography and therefore (under either (a) or (b)) desires a claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant in his next response to expressly indicate<sup>6</sup> the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at

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<sup>4</sup> It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

<sup>5</sup> See also MPEP §2111.

<sup>6</sup> “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted). “In the absence of an *express intent* to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning. We indulge a heavy presumption that a claim term carries its ordinary and customary meaning. [Emphasis added.]” *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (citations and quotations omitted).

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1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).<sup>7</sup> The Examiner cautions that no new matter is allowed.

Failure by Applicant in his next response to address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to forgo lexicography in this application and to continue having the claims interpreted with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that the above requirements are reasonable.<sup>8</sup> Unless expressly noted otherwise by the Examiner, the

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<sup>7</sup> See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.01, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

<sup>8</sup> The requirements are reasonable on at least two separate and independent grounds. First, the Examiner’s requirements are simply an express request for clarification of how Applicant intends his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant is not inadvertently overlooked by the Examiner. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed October 27, 2003).

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preceding discussion on claim interpretation principles applies to all examined claims currently pending.

17. To the extent that the Examiner's interpretations are in dispute with Applicant's interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.<sup>9</sup> Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.<sup>10</sup> Finally, the following list is not intended to be exhaustive in any way:

a. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.<sup>11</sup> **Client:** “3. On a local area network or Internet, a computer that accesses

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<sup>9</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

<sup>10</sup> See e.g. *Brookhill-Wilk I LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

<sup>11</sup> Based upon Applicant's disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner's finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” used to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP §2173.05(a) titled “New Terminology”.

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shared network resources provided by another computer (called a *server*).” *Id.* **Computer**: “Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” *Id.*

b. **Data** “Plural of the Latin *datum*, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” *Id.*

c. **Electronic** “2 : of, relating to, or utilizing devices constructed or working by the method or principles of electronics; also : implemented on or by means of a computer <~ food stamps> <~ banking>” *Id.*

d. **Associate**: “1: closely connected with one another . . .” Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

e. **Information** “ 2 a . . . (3): FACTS, DATA . . .” *Id.*

f. **Receipt** “5 : a writing acknowledging the receiving of goods or money” *Id.*

### **35 U.S.C. 112 6<sup>th</sup> paragraph**

18. The pending system claims are combination claims made of old and new elements. See *e.g. Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1190 (Fed. Cir. 2000)(noting that there is “a general rule that combination claims can consist of combinations of old elements as well as new elements”). Moreover, in combination claims, there is no essential element or “gist” of the invention. *Cooper Cameron Corp. v. Kvaerner Oilfield Products Inc.*, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002) (noting that “there is no legally

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recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”). In light of this fact and after further review of the specification, the Examiner finds that no *single* means-plus-function limitation in all pending claims is determinative of patentability. In other words, the Examiner finds that the means-plus-function limitations in the claims are *not* the *only* point of novelty; the limitations are *not* the only new element(s) in the claim(s). The Examiner therefore begins his §112 6<sup>th</sup> paragraph analysis with this presumption.

If Applicant disagrees with this presumption, the Examiner respectfully requests Applicant—for each “means for” phrase—to expressly traverse the Examiner’s presumption in their next properly filed response and provide appropriate arguments in support thereof. Failure by Applicant to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant to maintain the presumption that the means-plus-function limitations are *not* the claim(s)’ only point of novelty.

19. The following is a more detailed analysis of 35 U.S.C. 112 6<sup>th</sup> paragraph limitations now pending.

### **Means Phrase #1**

#### ***Invocation***

20. It is the Examiner’s position that the phrase “means for determining shelf-life limitation information” as recited in claim 1 (“Means Phrase #1”) is an attempt by Applicant to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in claim 1.



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**Invocation Prong 1:**

a. First, in accordance with the MPEP §2181, the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6*¶ (“Guidelines”)<sup>12</sup>, and *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166 (Fed. Cir. 1999),<sup>13</sup> Applicants use of “means for” in claim 1 creates a rebuttable presumption that tends to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. “It is well settled that a claim limitation that actually uses the word ‘means’ invokes a rebuttable presumption that § 112, ¶ 6 applies. . . . The term ‘means’ is central to the analysis.” *Apex Inc. v. Raritan Computer Inc.*, 66 USPQ2d 1444, 1450 (Fed. Cir. 2003) (internal citations and quotations omitted). Since “means for” is recited in Means Phrase #1, this step is clearly met.

**Invocation - Prong 2:**

b. Second, in accordance with MPEP §2181, the Guidelines, and *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001), it is the Examiner’s position that Applicant recites a corresponding function to the means—“determining shelf-life limitation information.”

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<sup>12</sup> Federal Register Vol 65, No 120, June 21, 2000.

<sup>13</sup> See also *Sage Prods., Inc. v. Devon Industry, Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997); *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583, 39 USPQ2d 1783, 1785 (Fed. Cir. 1996).

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The Examiner notes that when determining the function recited “[u]nless something in the written description suggests that the patentee intended the unambiguous language to be construed in a manner inconsistent with its ordinary meaning, we are bound by that language.” *Telemac Cellular Corp. v. Topp Telecom Inc.*, 58 USPQ2d 1545, 1550 (Fed. Cir. 2001). Because nothing in the specification suggests otherwise, the function as found in the Means Phrase #1 will have its ordinary meaning.

**Invocation - Prong 3:**

c. Third, in accordance with MPEP §2181, the Guidelines, and *Personalized Media Communications, LLC v. International Trade Commission*, 161 F.3d 696, 704, 48 USPQ2d at 1880, 1887 (Fed. Cir. 1998), the means-plus-function clause must not recite sufficient definite structure for performing that function.

In our case, Means Phrase #1 does not recite the structural elements which perform the function. In determining whether the presumption of invocation is rebutted, “the focus remains on whether the claim ... recites sufficiently definite structure.” *Id.* Furthermore, sufficient structure does not require an exhaustive recitation—only structure to perform entirely the claimed function. *Rodime PLC v. Seagate Technology Inc.*, 174 F.3d 1294, 1304, 50 USPQ2d 1429, 1436 (Fed. Cir. 1999). Clearly the “determining shelf-life limitation information” can not be entirely performed by the other recited structure in the claim.

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Because of the above, it is the Examiner's position that Means Phrase #1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

***Corresponding Structure, Material, or Acts***

21. In accordance with MPEP §2181, the Guidelines (section "II") and *Medtronic, Inc., v. Advanced Cardiovascular Systems, Inc.* 248 F.3d 1303, 58 USPQ2d 1607, 1614 (Fed. Cir. 2001), "[t]he next step is to determine the corresponding structure described in the specification and equivalents thereof. Structure disclosed in the written description is 'corresponding' to the claimed means under 35 U.S.C. 112 6<sup>th</sup> paragraph only if the structure is clearly linked by the written description . . . ." *Id.*

One of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links the means plus function claim limitation to any corresponding structure.

22. The Examiner will next apply the above reasoning to all claimed phrases that potentially invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Citations and authorities will be omitted for clarity.

**Means Phrase #2**

23. It is the Examiner's position that the "means for recording said shelf-life limitation information" ("Means Phrase #2") as recited in claim 1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

a. Means Phrase #2 meets Invocation Prong 1 because "means for" is recited.

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b. Means Phrase #2 meets Invocation Prong 2 because the phrase recites the function of “recording said shelf-life limitation information.” This function will have its ordinary and plain meaning.

c. Means Phrase #2 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of “recording said shelf-life limitation information.”

d. However one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

### **Means Phrase #3**

24. It is the Examiner’s position that the “means accessible to a point of sale terminal for each of one or more product items” (“Means Phrase #3”) in claim 1 does not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph.

a. Means Phrase #3 fails Invocation Prong 1 because “means for” is not recited. See MPEP §2181 and the Guidelines.

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**Means Phrase #4**

25. It is the Examiner's position that the "means for electronically recording said shelf-life limitation information" ("Means Phrase #4") in claim 1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means Phrase #4 meets Invocation Prong 1 because "means for" is recited.
- b. Means Phrase #4 meets Invocation Prong 2 because the phrase recites the function of "adjusting the torque percentage distribution." This function will have its ordinary and plain meaning.
- c. Means Phrase #4 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of "adjusting the torque percentage distribution."
- d. However one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

**Means Phrase #5**

26. It is the Examiner's position that the "means for retrieving the shelf-life limitation information" ("Means Phrase #5") in claim 1 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means Phrase #5 meets Invocation Prong 1 because "means for" is recited.

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b. Means Phrase #5 meets Invocation Prong 2 because the phrase recites the function of “retrieving the shelf-life limitation information.” This function will have its ordinary and plain meaning.

c. Means Phrase #5 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of “retrieving the shelf-life limitation information.”

d. However one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

#### **Means Phrase #6**

27. It is the Examiner’s position that the “means for storing said communicated electronic shelf-life limitation information for each of said one or more product items in a memory accessible by said microprocessor” (“Means Phrase #6”) in claim 3 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

a. Means Phrase #6 meets Invocation Prong 1 because “means for” is recited.

b. Means Phrase #6 meets Invocation Prong 2 because the phrase recites the function of “storing said communicated electronic shelf-life limitation information for each of said one or more product items in a memory accessible by said microprocessor.” This function will have its ordinary and plain meaning.

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c. Means Phrase #6 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of “storing said communicated electronic shelf-life limitation information for each of said one or more product items in a memory accessible by said microprocessor.”

d. Again, one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

#### **Means Phrase #7**

28. It is the Examiner’s position that the “means for formatting for an on-screen display said stored electronic shelf-life limitation information for each of said one or more product items” (“Means Phrase #7”) in claim 4 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

a. Means Phrase #7 meets Invocation Prong 1 because “means for” is recited.

b. Means Phrase #7 meets Invocation Prong 2 because the phrase recites the function of “formatting for an on-screen display said stored electronic shelf-life limitation information for each of said one or more product items.” This function will have its ordinary and plain meaning.

c. Means Phrase #7 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of “formatting for an on-screen display said stored electronic shelf-life limitation information for each of said one or more product items.”

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d. Again, one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

**Means Phrase #8**

29. It is the Examiner's position that the "means for displaying as an on-screen display said formatted electronic shelf-life limitation information for each of said one or more product items" ("Means Phrase #8") in claim 5 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means Phrase #8 meets Invocation Prong 1 because "means for" is recited.
- b. Means Phrase #8 meets Invocation Prong 2 because the phrase recites the function of "displaying as an on-screen display said formatted electronic shelf-life limitation information for each of said one or more product items." This function will have its ordinary and plain meaning.
- c. Means Phrase #8 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of "displaying as an on-screen display said formatted electronic shelf-life limitation information for each of said one or more product items."
- d. Again, one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.



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**Means Phrase #9**

30. It is the Examiner's position that the "means for the purchaser to interact with said onscreen display of said formatted electronic shelf-life limitation information for each of said one or more product items" ("Means Phrase #9") in claims 6-8 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means Phrase #9 meets Invocation Prong 1 because "means for" is recited.
- b. Means Phrase #9 meets Invocation Prong 2 because the phrase recites the function of "interact[ing] with said onscreen display of said formatted electronic shelf-life limitation information for each of said one or more product items." This function will have its ordinary and plain meaning.
- c. Means Phrase #9 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of "interact[ing] with said onscreen display of said formatted electronic shelf-life limitation information for each of said one or more product items."
- d. Again, one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

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**Means Phrase #10**

31. It is the Examiner's position that the "means for converting said read shelf-life limitation information for each of said one or more product items to an electronically readable and storable form" ("Means Phrase #10") in claim 7 invokes 35 U.S.C. 112 6<sup>th</sup> paragraph.

- a. Means Phrase #10 meets Invocation Prong 1 because "means for" is recited.
- b. Means Phrase #10 meets Invocation Prong 2 because the phrase recites the function of "converting said read shelf-life limitation information for each of said one or more product items to an electronically readable and storable form." This function will have its ordinary and plain meaning.
- c. Means Phrase #10 meets Invocation Prong 3 because the claim does not recite sufficient definite structure for performing the function of "converting said read shelf-life limitation information for each of said one or more product items to an electronically readable and storable form."
- d. Again, one of ordinary skill in the art however can not recognize the corresponding structure in this case. Neither the figures nor the specification clearly links or associates the means plus function claim limitation to any corresponding structure.

***Response to Arguments***

32. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

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33. The Examiner acknowledges Applicant's request to point out where in Colella the specific claimed elements are located.<sup>14</sup> The Examiner notes however that indefinite claims can not be construed. See *e.g. Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) ("Because the claims are indefinite, the claims, by definition, cannot be construed."). Yet in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though the claims contain 35 U.S.C. §112 2<sup>nd</sup> paragraph rejections, the claims are construed and the art is applied *as much as practically possible*. Upon appropriate resolution of the claim objections and the 35 U.S.C. §112 rejections, the claims will be reinterpreted to access claim scope and if not allowable, have the best prior art applied to the claims. As noted below, Applicant is invited to contact the Examiner if additional assistance is needed.

### ***Conclusion***

34. Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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<sup>14</sup> Applicant's Remarks/Arguments, Paper No. 15, Page 7, ~ lines 20-24.

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. The Examiner for this application has changed. As noted below, please indicate Andrew J. Fischer as the examiner of record in all future responses.

36. The prior art made of record considered pertinent to Applicant(s)' disclosure includes the following: Brown et. al. (U.S. 6,430,541 B1); Goodwin, III (U.S. 6,557,760 B2); Singh et. al. (U.S. 6,549,135 B2); Ching (U.S. 6,533,168 B1); Eidelson (U.S. 6,337,836 B1); Sone (U.S. 6,204,763 B1); Cesar et. al. (U.S. 6,172,596 B1); Hall (U.S. 6,131,399); Chenoweth et. al. (U.S. 6,019,394); Brewer et. al. (U.S. 6,012,041 A); Blackman (U.S. 6,009,400); Rothschild et. al. (U.S. 5,802,015 A); Namisniak et. al. (U.S. 5,711,160 A); Green et. al. (U.S. 5,664,110); and Ruppert et. al. (U.S. 5,640,002).

37. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8<sup>th</sup> Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

38. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

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*not* a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

39. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see *e.g.* “User Level Beginning . . .”), because of the references’ basic content (which is self-evident upon review of the references), and after further review of both the intrinsic evidence of record and the entire art

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now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of the knowledge and information contained within these three references.

40. It is the Examiner's factual determination that all limitations in claims 1, 3-9, and 34-40 have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion in this paragraph regarding the standard for claim rejections applies to all examined claims currently pending.

41. All factual findings and conclusions of law in this Office Action are based the entire record. Although the Examiner may have singled out various items of evidence (*e.g.* Colella) and expressly noted its content, the other documents now of record were also considered and applied when making the Examiner's factual findings and conclusions of law (see *e.g.* the prior art rejections above). Moreover, because many of the cannons of claim construction are generally viewed from a person of ordinary skill in the art,<sup>15</sup> the other documents of record not specifically

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<sup>15</sup> See *e.g.* *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986)(noting that the definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim).

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mentioned in the prior art rejection(s) above were nevertheless used in the Examiner's deliberative process to access, inter alia, the definiteness of the claims, the level of skill in the art, and ultimately the patentability of the claimed invention.

42. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks/Arguments" (Paper No. 15 beginning on page 6) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied<sup>16</sup>, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number

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<sup>16</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

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is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.

A handwritten signature in cursive script, followed by the date 10/27/03.

Andrew J. Fischer  
Patent Examiner

AJF  
October 27, 2003